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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,816	06/20/2003	Gena S. Whitney	D0251 NP	5150

23914 7590 03/29/2007  
LOUIS J. WILLE  
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PATENT DEPARTMENT  
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EXAMINER
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LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/600,816

Applicant(s)

WHITNEY ET AL.

Examiner

Ruixiang Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-44 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 39-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35, 36, and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1130/2007</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Application, Amendments, and/or Claims**

The amendment filed on 01/30/2007 has been entered. Claims 35 and 36 are amended. Claims 35-44 are pending. Claims 35, 36, and 38 are under consideration.

### **Withdrawn Objections and/or Rejections**

The objection to title is withdrawn in view of amended title.

The rejection of claims 35, 36, and 38 under 35 U.S.C. 112, first paragraph for scope of enablement is withdrawn in view of amended claims.

The rejection of claims 35, 36, and 38 under 35 U.S.C. 112, second paragraph is withdrawn in view of amended claims.

### **Information Disclosure Statement**

The information disclosure statement filed on 1/30/2007 has been considered by the examiner and an initialed copy has been attached to this office action

### **Claim Rejections Under 35 U. S. C. § 102 (e)**

(i). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(ii). The rejection of claims 35, 36, and 38 under 35 U.S.C. 102(e) as being anticipated by Veiby et al. (U.S. Pub. No. US2003/0068636 A1, April 10, 2003; 102(e) date: 06/21/2001) is maintained.

Applicants argue that Veiby et al. fails to teach all of the elements of claim 35 on account of it not disclosing a "polypeptide consisting of the sequence of amino acids 2 to 357 of SEQ ID NO: 3.

Applicants' argument has been fully considered, but is not deemed to be persuasive because claim 35, a) recites a step of determining the expression level of RNA encoding a polypeptide of the sequence of amino acids 2 to 357 of SEQ ID NO: 3 in a normal tissue sample and in a test tissue sample by measuring RNA of said polypeptide. Veiby et al. teach a nucleic acid marker (SEQ ID NO: 59) for breast cancer (see Table 2) that is 100% identical to the nucleic acid sequence of SEQ ID NO: 2 of the present invention (see sequence alignment attached to the previous office action), whereas the complementary sequence of such a nucleic acid sequence can be used to determine the expression level of RNA encoding a polypeptide consisting of 2 to 357 of SEQ ID NO: 3, as recited in claim 36, a).

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### **Conclusion**

No claims are allowed.

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on (571) 272-0835. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.



RUIXIANG LI, PH.D.  
PRIMARY EXAMINER

Ruixiang Li, Ph.D.  
Primary Examiner  
March 26, 2007